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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,806	01/09/2004	Joshua I. Halpern	1537-4	1579
28349 7590 09/30/2009 DILWORTH & BARRESE, LLP 1000 WOODBURY ROAD SUITE 405 WOODBURY, NY 11797				
EXAMINER PLUCINSKI, JAMESUE A				
ART UNIT		PAPER NUMBER		
3629				
MAIL DATE		DELIVERY MODE		
09/30/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/754,806

**Applicant(s)**

HALPERN ET AL.

**Examiner**

JAMISUE A. PLUCINSKI

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date 20051117
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Claims 51-53 in the reply filed on 6/4/09 is acknowledged.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 51 and 52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 51 recites the steps of qualifying the threat type and quantifying the threat type, first in the specification, the applicant claims this as being one step, a step of qualifying and quantifying the threat type, therefore it is unclear what steps are related to qualifying and what steps are related to quantifying in the specification. Second, in the specification, page 19 paragraph 0079 discloses the qualifying and quantifying step by determining a dollar loss value per instance and cost such as shielding a customer from SPAM, loss of productivity and the cost to deal with the SPAM is considered. The specification discloses what things are considered when qualifying and quantifying the threat, however never discloses how to determine a dollar loss value, how to determine the loss of productivity, and the cost to deal with the SPAM or shielding a customer from SPAM. Furthermore never disclosed how to use those numbers to determine a dollar loss value per

instance. Therefore, one of ordinary skill in the art would not know how to qualify and quantify a threat source.

*Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

a. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 51-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products", while a "process" consists of a series of steps or acts to be performed.

4. In Claims 51-53, the claims are drawn to a method. For purposes of 101, a "process" has been given a specialized, limited meaning by the courts. Based on *In re Bilski* (Federal Circuit 2007-1130), the court outlined a test used to determine whether a method satisfies 35 USC 101, is a machine-or-transformation test. *In re Bilski* states "the machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-

eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See Flook, 437 US at 590. Claims 51-53 are drawn to a method for enabling action against a threat source. The claimed steps of receiving, preserving, parsing, correlating, collecting, cross-referencing and storing are done involving emails on a computer, however can be done by a person sitting at a computer and as claimed, does not positively recite that the steps are computer implemented. It is not enough to be done utilizing a computer, but it must be done by the computer. Therefore the claims do not pass the machine-or-transformation test and are hence not directed to statutory subject matter.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 51-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Judge (US 2007/0300286).

7. With respect to Claim 51: Judge discloses the use of a method for enabling action against a threat source (see abstract) comprising:

- b. Receiving evidence relating the a plurality of unsolicited emails through a proprietary account and through a referral from a victim (Paragraphs 0044, 0046 and 0192);
  - c. Preserving the evidence in a secure evidence repository (Paragraph 0048 and 0193);
  - d. Parsing the evidence to extract data relating to threat types, sources, intermediate parties and beneficiaries, thereby producing parsed evidence (Paragraph 0194);
  - e. Correlating the parsed evidence to produce common threat types, sources, intermediaries, and beneficiaries relating to the unsolicited emails (Paragraph 0195);
  - f. Collecting information from both open and closed sources based on the correlating and Cross-referencing the information and the common threat types, sources, intermediaries and beneficiaries (Paragraphs 0196-0201); and
  - g. Storing a result of the cross-referencing (Paragraph 0206).
8. With respect to Claim 52: Judge discloses an Action engine, which qualifies the threat/anomaly and assigns a value to determine if the anomaly exceeds the threshold value (See Paragraphs 0196-0198 and 0210-0224).
9. With respect to Claim 53: Judge discloses the use of an action engine with an alert engine which outputs a signal, which may trigger an alert message or notification of an action to be performed (Paragraphs 0203-0205) and queries this information for the threat from an anomaly action table, which the examiner considers to be a form of intelligence (Paragraphs 0221-0222).

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Graham et al. (7,467,410) discloses the use of identifying network misuse, Aronson et al. (6654,787) discloses the use of filtering email messages on behalf of a client, and Trecka et al. (6,453,345) discloses the use of network surveillance to evaluate network attacks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/  
Primary Examiner, Art Unit 3629